REMARKS

Claims 1-30 remain in the application. Claims 20-23 have been allowed. Claim 24 has been amended. Claim 7 has been amended to put it into independent form. In view of the comments in the current office action, claims 7-11 should now be allowed.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 1-5 were rejected under 35 U.S.C. § 112, first paragraph. In particular, the Office Action states that "[c]laims 1-5 are single means claims or at least depend from a single means claim. Claim 1 is merely an apparatus, and claim 5 is merely a storage structure comprising a surface. Accordingly, these claims are of undue breadth. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983)."

The claim at issue in In re Hyatt is as follows:

> 35. A Fourier transform processor for generating Fourier transformed incremental output signals in response to incremental input signals, said Fourier transform processor comprising incremental means for incrementally generating the Fourier transformed incremental output signals in response to the incremental input signals. (emphasis supplied).

35 U.S.C. § 112, sixth paragraph, states that "[a]n element in a claim for a combination may be expressed as a means or step for performing a specified function ...." (emphasis supplied). In claim 35 of Hyatt, there is only one element after the transition word "comprising," and that element is written in "means-plus-function" language (i.e., "means for incrementally generating"). The holding of In Re Hyatt is that when a claim violates 35 U.S.C. § 112, sixth paragraph by including a single means element instead of a combination of elements, that claim is invalid under 35 U.S.C. § 112, first paragraph.

Claims 1 and 5 are not written in means-plus-function language and do not invoke 35 U.S.C. § 112, sixth paragraph. Accordingly, the single-means prohibition of In Re Hyatt does not apply to these claims or the claims that depend from them. Claim 1 refers to a magnetic ink, including a magnetic substance, and having a stored information signal. Claim 5 refers to a surface and magnetic ink applied to the surface where the ink is magnetized such as to contain an encoded information signal. In view of the above, reconsideration and withdrawal of the rejection of claims 1-5 under 35 U.S.C. § 112, first paragraph is respectfully requested.

Rejections Under 35 U.S.C. §§ 102(b) and 103(a)

Claims 1-3 and 5 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,563,401 to Lemelson ("Lemelson"). Claims 24-26 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,922,086 to Milford. Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lemelson in view of U.S. Patent No. 5,215,397 to Taguchi et al. ("Taguchi"). Claims 6, 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Publication No. JP 56162689 A to Shimoma et al. ("Shimoma") in view of U.S. Patent No. 4,087,789 to Beery ("Beery").

The present invention relates to a magnetic ink encoding system where an information signal is stored in the magnetic ink. In a magnetic ink system, a pen or other magnetic ink writing head leaves an ink substance upon a surface. The magnetic ink substance contains particles of a magnetic substance which are magnetized and can later be detected by a magnetic sensor. In an embodiment of the present invention, when ink is deposited upon a surface by a magnetic pen, the magnetic pen also magnetizes the ink with a time-varying magnetic field.

With respect to claims 1-3 and 5, the Lemelson disclosure purports to be directed to bar codes and methods. In the background section at Col. 1, lines 37-32, the disclosure states as follows, "[i]n another form, one or more of the bars of a bar code may be printed with ink of a different color to provide auxilliary information or may contain magnetic recording ink defining digital and/or analog recordings." There is nothing in Lemelson, however, that describes how magnetic recording is performed. Lemelson is also silent as to what a digital or analog recording is in the reference. In order for a reference to be applicable to a claim, it must provide an enabling disclosure (see MPEP section 2121). Since Lemelson provides no guidance as what the recordings are or how they would be part of an ink, the reference is not enabling and is not a proper reference under 35 U.S.C. §§ 102(b) or 103(a).

With respect to claim 4, aside from the deficiencies of Lemelson, Taguchi fails to disclose the feature of storing a time varying frequency signal in the ink as called for in this claim. Looking at Col. 5, lines 31-56, in particular lines 44-48, the piezoelectric transducers output a time varying signal. Such a signal is not stored in the ink on the page or read from the ink on the page. Instead, the piezoelectric transducers of the pen produce an electrical signal based on the strain exerted on them. Looking at elements 13x-z of Fig. 1, such transducers provide an indication of pressure, and thus, the distance moved by the pen.

With respect to claims 24-26, the Milford reference refers to the reading of characters on bank documents (not unlike what is described in the Background section (pages 1 and 2) of the present application). Independent claim 24 has been amended to bring out a feature of the present invention in that the varying magnetic flux is applied to the magnetic ink to store information in the magnetic ink. Such a feature is neither shown nor suggested by Milford. In Milford, the applied magnetic field is for the reading of data from the bank documents (e.g., checks) and not for the storing of information in the ink. As indicated in the first full paragraph of Col. 7, the documents to be scanned are of the same type as known in the art (e.g., as shown in the Background section of the present application).

With respect to claim 6, 17, and 18, the Shimoma and Beery references fail to teach, individually or in combination, features of these claims. Claim 6, for example, refers to a magnetic ink encoding stylus that includes a penpoint adapted to apply magnetic ink to a surface and a magnetic ink write head adapted to apply a varying magnetic flux to the magnetic ink as it is applied by the penpoint to the surface.

Shimoma refers to the use of a magnet to draw ink through a stylus. As indicated in the "Constitution" section of the English-language portion of this document, magnet 4 causes magnetic ink to 3 to rise so that it can be "flown or transferred" onto the surface. It is not clear at all from Shimoma that the magnetic flux is applied to the magnetic ink as it is applied to the surface. Nonetheless, Beery does not make up for the deficiencies of Shimoma. As indicated in its title, Beery refers to magnetic ink character recognition (MICR) systems. Such systems are described in the Background section of the present application. Though a varying magnetic field is used in Beery, such a field is used in the reading of characters that have previously been placed on a document. The "write" head imparts the varying field to the character, and the "read" head detects the resulting signal from the character to discern the presence of magnetic ink on the document. Note at Col. 2, lines 46-48, it states that "when a document bearing encoded characters formed of magnetizable ink passes through a write station ...." Since the characters are already present on the document before reaching the write and read stations of the MICR system, there is no teaching whatsoever for applying a varying magnetic flux to the magnetic ink as it is applied by the penpoint to the surface as recited in claim 6. Claims 17 and 18 depend from and further define claim 6.

In view of the above, reconsideration and withdrawal of the rejection of claims 1-6, 17-18 and 24-26 under 35 U.S.C. §§ 102(b) and 103(a) is respectfully requested.

CONCLUSION

Applicants respectfully submit that this application is in condition for allowance. A Notice of Allowance is earnestly solicited.

The Examiner is invited to contact the undersigned at (202) 220-4255 to discuss any matter concerning this application. The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 11-0600.

Respectfully submitted,
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